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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,295	12/11/2000	George Bradley Hobbs	10003974-1	3877

7590

04/21/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O.Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/734,295

Applicant(s)

HOBBS, GEORGE BRADLEY

Examiner

Saeid Ebrahimi-dehKordy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Response to Arguments**

1. Applicant's arguments filed 10/20/04 have been fully considered but they are not persuasive. Applicant request that the Examiner provide a copy of application No. 09,581,306 and identify where the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application.
2. Examiner points out the section that the subject matter used to make the rejection are mentioned next to each parentheses in double parentheses.
3. the portions of the application 09,581,306 which was used to reject the claims are being presented for the applicant

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Zehr et al (Pup.

No.: US 20010025274 A1)

Regarding claim 1,11 and 19 Zehr et al disclose: A method of processing a print job of a customer and including advertising with the print job (please note Fig.2 items 26,66 and 44) the method comprising the steps of: defining a print processing system controller having a plurality of advertisements registered therewith (please note Fig.2 and page 5

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lines 6-8) defining a network communication link between the customer and the print processing system controller (please note Fig.1 and 2 the way mail sender is communicating through the network to the advertisements and LPFs, page 2 paragraph 0027 through 0032) ((page 4 lines 27-34 and page 5 lines 1-31)) receiving a data file for the print job from the customer at the print processing system controller via the network communication link (please note Fig.2, items 26,34 and 66 where the received email or (data file) is received by the communication link to POD and AD compiler, page 2 paragraph 0030 through 0033) ((page 5 lines 11-34 and page 6 lines 1-7)) and associating at least one of the advertisements with the print job based on the data file for the print job (please note Fig.2&4 page 3 paragraph 0039 through 0040) ((please note page 8 lines 10-34 and page 9 lines 1-8)).

Regarding claim 2,12 ,21 and 27 Zehr et al disclose: The method of claim 1, wherein the step of defining the network communication link includes defining an Internet communication link between the customer and the print processing system controller (please note page 2 paragraph 0030) or ((page 5 lines 11-16))

Regarding claim 3, and 22 Zehr et al disclose: The method of claim 1, wherein the step of associating the at least one of the advertisements includes processing the data file for the print job and determining from the data file a content of the print job (please note page 4 paragraph 0040 lines 20-31) or ((page 9 lines 1-8)).

Regarding claim 4,14 and 23 Zehr et al disclose: The method of claim 3, wherein each of the advertisements have a profile associated therewith, and wherein the step of associating the at least one of the advertisements includes comparing the content of the

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print job with the profile of the advertisements (please note page 4 paragraph 0040) or ((page 8 lines 23-34 and page 9 lines 1-8)).

Regarding claim 5, 13 and 24 Zehr et al disclose: The method of claim 4, wherein the step of associating the at least one of the advertisements includes associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (please note page 5 paragraph 0047) or ((page 11 lines 5-17)).

Regarding claim 6 Zehr et al disclose: The method of claim 1, further comprising the step of: printing the print job (please note Fig.2 item 44 where the mail object is printed, page 2 paragraph 0025) or ((page 4 lines 7-16)) and wherein the step of associating the at least one of the advertisements includes printing the at least one of the advertisements with the print job (please note page 3 paragraph 0039) or ((page 8 lines 10-22)).

Regarding claim 7, 15 and 25 Zehr et al disclose: The method of claim 6, wherein the step of associating the at least one of the advertisements includes querying the customer for approval of associating the at least one of the advertisements with the print job and receiving a response thereto, and wherein printing the at least one of the advertisements includes printing the at least one of the advertisements with the print job if the response is favorable (please note page 2 paragraph 0031) or ((page 5 lines 17-32)).

Regarding claim 8 and 16 Zehr et al disclose: The method of claim 1, further comprising the step of: registering the advertisements with the print processing system

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Controller (please note page 3 paragraph 0039) or ((page 8 lines 10-22)).

Regarding claim 9,17 and 26 Zehr et al disclose: The method of claim 8, wherein the step of defining the network communication link includes defining the network communication link between at least one advertiser, the customer, and the print processing system controller (please note Fig.2 items 26,66 and 44, page 2 paragraphs 0027 through 0032) or ((page 4 lines 27-34 and page 5 lines 1-31)) and wherein the step of registering the advertisements includes registering at least one advertisement of the at least one advertiser with the print processing system controller via the network communication link (please note page 3 paragraphs 0039) or ((page 8 lines 10-22)).

Regarding claim 10 and 18 Zehr et al disclose: The method of claim 8, wherein the step of registering the advertisements includes storing the advertisements and wherein the step of associating the at least one of the advertisements includes retrieving the at least one of the advertisements (please note page 4 paragraph 0040) or ((page 8 lines 23-34 and page 9 lines 1-8)).

Regarding claim 20 Zehr et al disclose: The system of claim 19, wherein the print processing system controller is configured to communicate with the customer via a network communication link (please note Fig.2 items 26,34,66 and 44) and wherein the print processing system controller is adapted to receive the data file for the print job from the customer via the network communication link (please note page2 paragraph 0027 through 0030) or ((page 4 lines 27-34 and page 5 lines 1-16)).

Regarding claim 28 Zehr et al disclose: The system of claim 19, further comprising: a print processing data storage system configured to communicate with the

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print processing system controller and store the advertisements therein (please note page 4 paragraph 0040) or ((page 8 lines 22-34 and page 9 lines 1-8)).

### **Conclusion**

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Contact Information**

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

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**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please  
mark

**"EXPEDITED PROCEDURE"**)

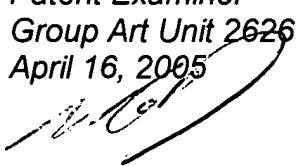
**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
"PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2626  
April 16, 2005



  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER